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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,345	10/14/2003	Dale W. Malik	190250-1230	7192
38823 7590 03/24/2008 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994				
EXAMINER KIM, HEE SOO				
ART UNIT 2157		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,345

**Applicant(s)**

MALIK ET AL.

**Examiner**

HEE SOO KIM

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 2/20/04, 5/24/04, 1/7/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to application filed on October 14, 2003.

Claims 1~22 are pending examination.

#### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 02/20/04, 05/24/04, and 1/07/08 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "access to the group email folder" in lines 6~7. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: an address book is needed in the system of claim 19 which is dependent upon for the email folder properties to contain address book settings.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1~10, 13~16, 18, 19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sumner et al. hereinafter Sumner (U.S. 2002/00601003).

Regarding Claim 1,

Sumner taught a communication method comprising the steps of:

providing a user profile having a collection of properties related to a user email folder (Par. [0035]), the user profile further having a collection of properties related to a user instant messaging (IM) account (Par. [0036], [0037], [0045], the wireless messaging engine facilitate the communication of different messaging services (may include IM messages) and utilizes the profile information located in the database to determine the proper method to handle the message);

defining properties of the user email folder using the user profile (Par. [0038], [0043]); and

defining properties of the user IM account using the user profile (Par. [0036], [0037], [0045]).

Regarding Claim 2,

Sumner taught the step of providing the user profiles comprises the step of:

assigning a user profile to a user (Par. [0035]);

permitting the user assigned to the user profile to have access to the at least one user email folder associated with the user profile (Par. [0036]); and

permitting the user assigned to the user profile to have access to the group email folder (Par. [0043], users with more than one e-mail address (more than one folder for each account) are consolidated into a single inbox for access).

Regarding Claim 3.

Sumner taught a communication method comprising the steps of:

assigning a user profile to a user (Par. [0035]);

associating a user email folder with the user profile (Par. [0035], [0039]); and

associating a user instant messaging (IM) account with the user profile (Par. [0035], [0039]).

Regarding Claim 4.

Sumner taught the step of:

defining properties associated with the user email folder as a function of the user profile (Par. [0038]).

Regarding Claim 5.

Sumner taught the step of defining properties associated with the user email folder comprises the steps of:

assigning a user name associated with the user (Par. [0038], profile information inherently contains login information such as username and password); and

assigning a password associated with the user name (Par. [0038]).

Regarding Claim 6.

Sumner taught the step of defining properties associated with the user email folder comprises the step of:

assigning a user type associated with the user (Par. [0038], profile can determine message content user is capable of receiving depending on how it is received (in this case, the wireless subscriber unit is a user type)).

Regarding Claim 7,

Sumner taught the step of defining properties associated with the user email folder comprises the step of:

assigning a collection of email folders to the user (Par. [0043], users with more than one e-mail address (more than one folder for each account) are consolidated into a single inbox for access).

Regarding Claim 8,

Sumner taught the step of assigning the collection of email folders to the user comprises the step of:

storing post office protocol 3 (POP3) server information for each email folder in the collection of email folders (Par. [0038], [0040], profile information inherently contains login information such as username and password, server information (protocols for accessing e-mails)).

Regarding Claim 9,

Sumner taught the step of assigning the collection of email folders to the user comprises the step of:

storing simple mail transfer protocol (SMTP) server information for each email folder in the collection of email folders (Par. [0038], [0040], profile information inherently contains login information such as username and password, server information (protocols for accessing e-mails)).

Regarding Claim 10,

Sumner taught the step of defining properties associated with the user email folder comprises the step of:

storing email filter settings (Par. [0038], [0040], profile information inherently contains login information such as username and password, server information (protocols for accessing e-mails) and filter settings).

Regarding Claim 13,

Sumner taught the step of:

defining properties associated with the user IM account as a function of the user profile (Par. [0038]).

Regarding Claim 14,

Sumner taught the step of defining properties associated with the user IM account comprises the steps of:

assigning a user name associated with the user (Par. [0038], profile information inherently contains login information such as username and password); and

assigning a password associated with the user name (Par. [0038]).

Regarding Claim 15,

Sumner taught the step of defining properties associated with the user IM account comprises the step of:

assigning a user type associated with the user (Par. [0038], profile can determine message content user is capable of receiving depending on how it is received (in this case, the wireless subscriber unit is a user type)).

Regarding Claim 16,

Sumner taught the step of defining properties associated with the user IM account comprises the step of:

assigning a collection of IM accounts to the user (Par. [0043]).

Regarding Claim 18,

Sumner taught a communication system comprising:

a user profile (Par. [0035]);

a user email folder associated with the user profile (Par. [0035], [0039]); and

a user instant messaging (IM) account associated with the user profile (Par. [0035], [0039]).

Regarding Claim 19,

Sumner taught the user profile is configured to define properties associated with the user email folder (Par. [0038]).

Regarding Claim 21,

Sumner taught the user profile is configured to define properties associated with the user IM account (Par. [0038]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11, 12, 17, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumner in view of Chen et al. hereinafter Chen (U.S. 2002/0049751).

Regarding Claim 11,

Sumner taught substantially all the limitations of claim 4, however, failed to specifically teach the step of defining properties associated with the user email folder comprises the step of storing an address book associated with the user.

Chen taught managing contact information where a registered user's record in the communication network, include profile information representing a contact list (address book) containing list of contacts (Par. [0031]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Sumner's system, Chen's contact list containing list of contacts as it would provide hassle-free communication with the users in the contact list without the need to memorize their contact information.

Regarding Claim 12,

Sumner taught substantially all the limitations of claim 11, however, failed to specifically teach the step of storing the address book associated with the user comprises the step of assigning address book settings to the address book.

Chen taught managing contact information where a registered user's record in the communication network, include profile information representing a contact list containing list of contacts. Users may choose to have their profile updated automatically (obviously a form of address book setting) in the server whenever updates or new entries are entered in the database (Par. [0031], [0035]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Sumner's system, Chen's contact list containing list of contacts and settings (i.e. automatic contact list updates) as it would provide uninterrupted communication with the users in the list as the server is continuously monitoring for any updates in the contact information.

Regarding Claim 17,

Sumner taught substantially all the limitations of claim 13, however, failed to specifically teach the step of storing a contact list associated with the user.

Chen taught managing contact information where a registered user's record in the communication network, include profile information representing a contact list (address book) containing list of contacts (Par. [0031]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Sumner's system, Chen's contact list containing list of contacts. See motivation above.

Regarding Claim 20,

Sumner taught the properties associated with the user email folder include at least one property selected from the group consisting of: a user name and password (Par. [0038], profile information inherently contains login information such as username and password); post office protocol 3 (POP3) and simple mail transfer protocol (SMTP) server information (Par. [0038], [0040], profile information inherently contains login information such as username and password, server information (protocols for accessing e-mails)); server information (Par. [0036]); a collection of email folders (Par. [0043], users with more than one e-mail address (more than one folder for each account) are consolidated into a single inbox for access); a user type (Par. [0038], profile can determine message content user is capable of receiving depending on how it is received (in this case, the wireless subscriber unit is a user type)); an email filter setting (Par. [0038], [0040], profile information inherently contains login information such as username and password, server information (protocols for accessing e-mails) and filter settings) however, did not specifically teach an address book setting.

Chen taught managing contact information where a registered user's record in the communication network, include profile information representing a contact list containing list of contacts. Users may choose to have their profile updated automatically (obviously a form of address book setting) in the server whenever updates or new entries are entered in the database (Par. [0031], [0035]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Sumner's system, Chen's contact list containing list of contacts and settings (i.e. automatic contact list updates) as it would

provide uninterrupted communication with the users in the list as the server is continuously monitoring for any updates in the contact information.

Regarding Claim 22,

Sumner taught the properties associated with the user IM account include at least one property selected from the group consisting of: a user name and password (Par. [0038], profile information inherently contains login information such as username and password); a collection of IM accounts (Par. [0043]); however, did not specifically teach a contact list.

Chen taught managing contact information where a registered user's record in the communication network, include profile information representing a contact list (address book) containing list of contacts (Par. [0031]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Sumner's system, Chen's contact list containing list of contacts. See motivation above.

***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hee Soo Kim whose telephone number is (571) 270-3229. The examiner can normally be reached on Monday - Thursday 8:00AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HEE SOO KIM/  
3/13/08

Art Unit: 2157

/Ario Etienne/

Supervisory Patent Examiner, Art Unit 2157